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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PICKETT, JOHN G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 07/31/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/736,057

Applicant(s)

RAVITZ ET AL.

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This Office action acknowledges the applicant's Amendment A, presented as Paper No. 7. Claims 1-31 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 30 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation "the lines" renders both claims indefinite since it is unclear as to whether the width lines or length lines are parallel.

***Claim Rejections - 35 USC § 102***

4. Claims 1-5, 7, 10, 12-13, 15-16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Potter (US 5,714,098).

Regarding claim 1, Potter discloses a foot wear fitting method (Figure 11) comprising the steps of maintaining an inventory of shoes (63), measuring the size and

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width (55) and arch height (Col. 5, In 34-37), selecting the proper size (63), and fitting the shoe to the customer (75).

On page 15, lines 5-9 of the specification of the present application, applicant defines the flat inner foot receiving surface as having all arch support or otherwise normally provided cushioning removed. Potter anticipates inserting an orthotic onto the flat inner foot receiving surface of the shoe (Col. 9, In 26-41). The examiner interprets the broad term, insert, used by Potter, to include orthotics.

As to claims 2-3, Potter anticipates an inventory of prefabricated orthotics (Col. 9, In 34-36).

As to claims 4-5, Potter anticipates a custom made orthotic fabricated from the size, width, and arch height for each foot (Col. 9, In 42-50).

As to claim 7, Potter anticipates a variety of shoe types, including dress shoes (Col. 5, In 41-46).

As to claims 12-13, Potter anticipates a system having an inventory of shoes (step 63), sample insoles are a device for measuring the size, width and arch height (Col. 9, In 42-44), an inventory of prefabricated orthotics having a range of sizes and arch heights (Col. 9, In 26-41), and fitting the combination on the customer (step 75).

As to claims 15-16, Potter anticipates a system having an inventory of shoes (step 63), sample insoles are a device for measuring the size, width and arch height (Col. 9, In 42-44), custom made orthotics fabricated from the measurements of the size, width, and arch heights (Col. 9, In 42-50), and fitting the combination on the customer (step 75).

As to claim 18, Potter anticipates a variety of shoe types, including dress shoes (Col. 5, In 41-46).

***Claim Rejections - 35 USC § 103***

5. Claims 6, 8-11, 17, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potter.

Regarding claims 6 and 17, Potter discloses a method and system as applied to claims 1 and 15 above. Potter does not disclose an orthotic which is a prescription orthotic.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use prescription orthotics in the method and system of Potter in order to offset the price of the shoe to the customer through insurance coverage available through a prescription orthotic.

As to claims 8-9 and 19-20, Potter discloses a method and system as applied to claims 1 and 15 above. Potter does not expressly disclose women's fashion shoes.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make women's fashion shoes available to the method and system of Potter in order to supply a greater choice to female customer's.

As to claim 10, Potter discloses the claimed invention except for measuring one of only three foot widths. Potter teaches the use of finer width increments to increase the quality of fit for the wearer, thereby indicating that width increments are proportional to fit quality (see Col. 1, In 35-62). By its inverse, if fit quality is not of concern,

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reduction of width increments can be obtained. It would have been obvious to one of ordinary skill in the art at the time the invention was made to reduce the width increments of Potter to limit tooling and equipment costs. Further, it has been held that omission of an element and its function in a combination where the remaining elements perform the same function involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

As to claim 11, Potter discloses a method as applied to claim 1 above. Potter does not disclose the selection of the shoe style over the Internet.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide shoe selection options over the Internet to the method of Potter in order to reduce inventory requirements at the retail store.

6. Claims 14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potter as applied to claims 12 and 15 above, and further in view of Yates (GB 2 115 164 A).

Regarding claims 14 and 21, Potter discloses a system as applied to claims 12 and 15 above. Potter does not disclose a device for measuring width that includes indicia for measuring only one of three foot widths.

Yates discloses a width measuring device that provides for only three width zones (half size larger, size indicated, and ask sales assistant)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the Yates device in the system of Potter in order to pre-size

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the customer's foot and reduce the number of sample insoles required to be tried by the customer, thereby expediting the sizing process.

7. Claims 22-24, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pietzuch (US 1,324,267) in view of Scholl (US 2,480,776).

Regarding claim 22, Pietzuch discloses a device (21) with a surface for receiving a foot (20), a first reference (28), a second reference (26), a third reference (27), a first indicia (23), and a second and third indicia (24, 25).

Pietzuch does not disclose a first and second mechanism for measuring the height of the arch of the foot.

Scholl discloses a mechanism (22, 24, 27, 28) for measuring the height of the arch of the foot. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Pietzuch with a mechanism as taught by Scholl in order to measure the height of the arch of a foot and customize a shoe accordingly (see for example, Scholl, Col. 1, ll. 15-19). It would have further been obvious to provide two devices in order to maintain the symmetry of the Pietzuch device.

As to claim 23, the device of Pietzuch-Scholl discloses the claimed invention except for only three lines for width measurement. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Pietzuch-Scholl with only three lines since it has been held that omission of an element

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and its function in a combination where the remaining elements perform the same function involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

As to claim 24, the device of Pietzuch-Scholl discloses a first and second mechanism comprising a wedge (Scholl, 22) movable longitudinally towards and away from the arch of a foot by means of a slot (25). The device of Pietzuch-Scholl would have anticipated indicia (see for example, Scholl, Col. 2, ll. 42-47).

As to claim 30, the device of Pietzuch-Scholl discloses parallel width lines (Pietzuch, Figure 1).

8. Claims 25-26, 28-29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rolloff et al. (US 5,640,779) in view of Legg Jr. (US 2,518,798).

Regarding claim 25, Rolloff et al. discloses a device 10 for measuring foot size with housing 14, first reference 52, second reference 54, third reference 56, and scanners 108. The device of Rolloff et al is capable of use in a centerline reference manner and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use it in such a manner in order to account for variations on the outside of the user's foot.

Rolloff et al. does not expressly disclose first, second, and third indicia.

Legg Jr. discloses a device for measuring a foot with indicia as claimed by the applicant. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Rolloff et al. with indicia as taught by Legg Jr. and claimed by the applicant in order to visually verify the measurements taken by



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the device and further to quickly determine shoe sizing for reception of the completed orthotic.

As to claim 26, the device of Rolloff-Legg discloses the claimed invention except for only three lines for width measurement. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Rolloff-Legg with only three lines since it has been held that omission of an element and its function in a combination where the remaining elements perform the same function involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

As to claim 28, the device of Rolloff-Legg discloses a processor (Rolloff, 162).

As to claim 29, the device of Rolloff-Legg discloses a modeler (Rolloff, 216).

As to claim 31, the device of Rolloff-Legg discloses parallel width lines (Legg Jr., 26, 27).

9. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rolloff et al. in view of Legg Jr. as applied to claim 25 above, and further in view of White (US 5,237,520).

Rolloff-Legg discloses a device as mentioned and modified above. Rolloff-Legg does not disclose scanners comprising CCD imagers.

White discloses a foot sizing device with laser-optic scanners (Col. 5, ln 45-52). Laser-optic scanners use a CCD array.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Rolloff-Legg with CCD imagers as taught by

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White in order to reduce the number of moving parts necessary for the device to function.

### ***Response to Arguments***

10. Applicant's arguments filed May 19, 2003 have been fully considered but they are not persuasive.

The examiner does not agree with the applicant's argument that Potter (US 5,714,098) does not teach a flat inner surface. The inserts of Potter (which the examiner interprets as including orthotics) are formed separately from the shoe by means of molding apparatus (77, Figure 12). As indicated in Figure 12, the molding apparatus includes one contoured half (79b, 80b) and one flat half (79a, 80a). Since one half of the insert is flat it must follow that the surface on which it is mounted is also flat. Therefore, Potter inherently teaches a flat inner surface.

Applicant's arguments with respect to claims 10, 14, and 21 have been considered but are moot in view of the new ground(s) of rejection. The new grounds of rejection were necessitated by the addition of limitations requiring only three width increments.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., size selected over the Internet) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057

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(Fed. Cir. 1993). The applicant has claimed the selection of styles over the Internet. In the case of the custom forming of an insert to be placed in a prefabricated shoe, the selection of the style of shoe over the Internet would not have interfered with the sizing process of Potter since the insert could have been formed and the style of shoe ordered separately. Thus the motivation of reduced inventory on location could have been maintained.

Applicant's arguments with respect to claims 22-24 have been considered but are moot in view of the new ground(s) of rejection. The new grounds of rejection were necessitated by the addition of limitations requiring center axis placement of the foot.

Applicant's arguments with respect to claims 25-29 have been considered but are moot in view of the new ground(s) of rejection. The new grounds of rejection were necessitated by the addition of limitations requiring center axis placement of the foot.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rosenberg et al and Iberg disclose foot measuring devices using a center reference arrangement.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

*GP*  
Gregory Pickett  
Examiner  
July 15, 2003

  
Mickey Yu  
Supervisory Patent Examiner  
Group 3700